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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/808,832 | 03/15/2001 | Robert A. Copcland | PH-7134 | 5618 |
| 23914 | 7590 | 05/07/2004 | EXAMINER | |
| STEPHEN B. DAVIS BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000 | | | RUSSEL, JEFFREY E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1654 | |
| DATE MAILED: 05/07/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,832

Applicant(s)

COPELAND ET AL.

Examiner

Jeffrey E. Russel

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 35-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-29 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-14 and 35-42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

1) (PTO-892)
2) Patent Drawing Review (PTO-948)
3) Statement(s) (PTO-1449 or PTO/SB/08)

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. This application is in condition for allowance except for the following formal matters:

(a) This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the following reasons:

The Sequence Listing filed April 21, 2004 is objected to Applicants did not provide a statement that the content of the paper and computer readable copies include no new matter as required by 37 CFR 1.825(a).

Correction is required.

The Sequence Listing filed April 21, 2004 was approved by STIC for matters of form.

(b) The substitute specification filed April 21, 2004 has been entered. The substitute specification is objected to because there are no amino acid sequences in the substitute specification which have been labeled as SEQ ID NOS:14, 15, or 16. The relationship between SEQ ID NOS:14-16 as set forth in the Sequence Listing filed April 21, 2004 and the disclosure of the invention is unclear. Further, the substitute specification is objected to because in at least one instance, the clean copy of the substitute specification does not correspond with the marked-up copy of the substitute specification. Compare page 67 of the clean copy, last line of Table 1 (“(SEQ ID NO:239)”), and page 73 of the marked-up copy, last line of Table 1 (“(SEQ ID NO:243)”). Applicants need to review the substitute specification and ensure that the correct and intended text is present in the clean copy.

Correction is required.

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(c) Claims 1-14 and 35-42 are objected to because: Claim 1 is presented as a "Previously presented" claim. However, it contains an amendment marking from a previous amendment to this claim. See page 2, last line, the crossed-out "n" before "natural". At claim 1, page 3, proviso f), the SEQ ID NOS were not updated to reflect the new numbering in the Sequence Listing filed April 21, 2004. The amino acid sequences should be identified as SEQ ID NOS:225, 226, 227, and 230, respectively. Claims 41 and 42 are identified as "(NEW)" claims even though they contain amendment markings.

Correction is required.

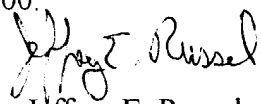
Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

2. Claims 15-29 are allowed. Claims 1-14 and 35-42 would be allowable if rewritten or amended to overcome the claim objections set forth in this Office action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (571) 272-0969. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Brenda Brumback can be reached at (571) 272-0961. The fax number for formal communications to be entered into the record is (703) 872-9306; for informal communications such as proposed amendments, the fax number (571) 273-0969 can be used. The telephone number for the Technology Center 1600 receptionist is (571) 272-1600.


Jeffrey E. Russel
Primary Patent Examiner
Art Unit 1654

JRussel
May 4, 2004